

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed July 11, 2005. Claims 1 and 27 are amended herein, and claims 19-22 are withdrawn. Claims 1-8 and 27-29 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 102

The Examiner rejected all pending claims as anticipated under 35 U.S.C. § 102 by one or more of the following references: U.S. Patent No. 6,668,000 to Choa (“Choa”); U.S. Patent No. 6,631,005 to Komazaki *et al.* (“Komazaki”); and U.S. Patent No. 5,694,048 to Boudreau *et al.* (“Boudreau”). Specifically, the Examiner rejected claims 1-6 and 27-29 as anticipated under 35 U.S.C. § 102(e) by Choa, rejected claims 1-3, 5, 7, 8, 27 and 28 as anticipated under 35 U.S.C. § 102(e) by Komazaki, and rejected claims 1-3, 5, 7, 8, 27-29 as anticipated under 35 U.S.C. § 102(b) by Boudreau.

Applicant respectfully traverses the Examiner’s rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained below, Choa, Komazaki and Boudreau cannot anticipate the claims they were used to reject because they do not disclose every element and limitation recited therein.

Claim 1 is not anticipated by Choa, Komazaki or Boudreau.

Claim 1, as amended, recites a method combination including “removably optically coupling a test structure to a device on a wafer, the test structure included on the wafer”

wherein the test structure is optically coupled to the device in a manner to allow the interface to direct a light beam emitted from the device in a direction different from an original direction of the emitted light beam. None of Choa, Komazaki or Boudreau disclose a combination including the recited limitations.

Choa, in figure 4, discloses a laser 300 including an active region 310 and a scattering trench 340 formed in the laser 300. The Examiner characterizes the scattering trench 340 as a test structure. Accepting for the sake of argument the Examiner's characterization of the scattering trench 340, Choa discloses that the scattering trench 340 is an integral part of the laser 300, meaning that it cannot be removable from the laser. Choa therefore cannot disclose, teach or suggest the recited method combination, which includes "removably optically coupling a test structure to a device on a wafer, the test structure included on the wafer."

Komazaki, in figures 2 and 5, describes an optical displacement sensor. In figure 2, the Examiner characterized grating 50 as a "test structure," while in figure 5 the examiner appears to characterize mirror 48 as a test structure. Accepting, for the sake of argument, the Examiner's characterization of these elements "test structures," Komazaki would not anticipate the claim. Why? Because Komazaki discloses that the grating 50 or mirror 48 are needed during—and, in fact, are critical to—the operation of the device as an optical displacement sensor (see, for example, figures 4A-4B, 6A-6B). Komazaki therefore cannot disclose, teach or suggest the recited method combination, which includes "removably optically coupling a test structure to a device on a wafer, the test structure included on the wafer."

Boudreau, in figure 1a, discloses a monitor-detector assembly. The assembly includes a laser 102 and a detector 103. The laser and detector are optically coupled to each other by a v-groove 105, which the Examiner characterizes as a test structure.” Boudreau further discloses that the purpose of the v-groove 105 is to allow the detector 103 to monitor the laser 102 during operation (col. 1, lines 49-53), meaning that the v-groove is crucial to the operation of the Boudreau device and cannot be removed. Boudreau therefore cannot disclose, teach or suggest the recited method combination, which includes “removably optically coupling a test structure to a device on a wafer, the test structure included on the wafer.”

For the reasons discussed above, Applicant submits that Choa, Komazaki and Boudreau cannot anticipate claim 1. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 2-8, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See generally* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant respectfully submits that claims 2-8 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 27 is not anticipated by Choa, Komazaki or Boudreau.

Claim 27, as amended, recites a method combination including directing a light beam emitted from a device in a wafer in a direction different from an original direction of the light beam as emitted from the device, via use of a test structure “included on the wafer

and removably optically coupled to the device.” By analogy to the discussion above in connection with claim 1, Applicant submits that none of these references can anticipate the claim because none of the reference discloses, teaches or suggests the recited method combination, which includes re-directing a light beam via use of a test structure “included on the wafer and removably optically coupled to the device.” Applicant submits that Choa, Komazaki and Boudreau cannot anticipate claim 27 and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 28-29, if an independent claim is allowable, then any claim depending therefrom is also allowable. *See generally* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 27 is in condition for allowance. Applicant respectfully submits that claims 28-29 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 10-11-05



Todd M. Becker
Attorney for Applicant(s)
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606

Enclosures: Postcard
Amendment transmittal, in duplicate